

REMARKS

Claims 1-35 and 86-99, 107, 112, 117-119 are pending, claims 36-85, 100-106, 108-111, and 113-116 having been canceled by the above or earlier amendments. Claims 1-23, 32, 33, 86, 88-93, and 95-98 are subject to examination. Claims 1, 16, 21, 95, 96, and 97 are currently amended. Support for the amendments to claims 1, 21, 95, 96, and 97 can be found, e.g., at page 2, line 20.

Objections to the Specification

The specification has been amended to remove hyperlinks.

Rejection for Alleged Lack of Written Description under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-23, 32-33, 86, 88-93, and 95-98 for “failing to comply with the written description requirement.” Page 5 of the Action dated June 2, 2004.

The Examiner’s rejection appears to turn on whether the term “non-naturally occurring” could ever provide an adequate written description. The Examiner concluded that, at page 6 of the Action dated June 2, 2004:

All naturally occurring proteins are not even close to being known or described. Because the hybrid nucleic acids are defined as non-naturally occurring, there must be description of all naturally occurring proteins in order to exclude them from the hybrid nucleic acids used in the claims.

The Applicants respectfully disagree. However, to expedite prosecution, the claims have been amended and no longer recite the term “non-naturally occurring.” Since this amendment should obviate the basis for the Examiner’s rejection, the Applicants submit that the rejection can be withdrawn.

Rejections for Alleged Indefiniteness under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 16-20 as indefinite. In particular, the Examiner indicated on page 9 of the Action dated June 2, 2004:

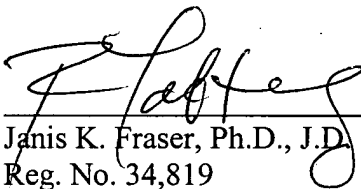
[T]he use of "when a transcription factor recognizes both a recruitment site and a target site of the promoter, but not when the transcription factor recognizes only the recruitment site of the promoter" in conjunction with the remaining steps renders the claims vague and indefinite because the relationship between the transcription factor and the hybrid nucleic acids made by steps (b)-(c) is unclear. Is the transcription factor made by the hybrid nucleic acids? Or, is it a separate transcription factor and the hybrid nucleic acids produce a separate transcription factor that competes with the transcription factor of step (a). Amending the claims to clearly indicate whether the hybrid nucleic acids encode the transcription factor or an additional transcription factor would be remedial.

The Applicants respectfully disagree with the Examiner's contention that claim 16 is indefinite. However, to expedite prosecution, the Applicants have amended Claim 16 according to the Examiner's suggestion. The hybrid nucleic acids recited in claim 16 encode transcription factors. The method of claim 16 does not require a "separate" transcription factor in addition to those encoded by the hybrid nucleic acids.

Enclosed is Petition for Extension of Time and a check for the required fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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